

Appin. No. 10/722,847
Docket No. 14XZ130600/GEM-0104

REMARKS / ARGUMENTS

Status of Claims

Claims 1-15 are pending in the application and stand rejected. Applicant has amended Claims 1 and 13, and has added new Claim 16, leaving Claims 1-16 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 6 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Chevassus et al. (U.S. Patent No. 6,342,878, hereinafter Chevassus).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claim 1 to now recite, inter alia:

“...means for actuating by direct manual input by a hand of the user to control...”.

Applicant has amended Claim 13 to now recite, inter alia:

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“...the assembly comprising means actuated by direct manual input by a hand of the user to control...”.

No new matter has been added by these amendments as antecedent support may be found in the specification as originally filed, such as at Paragraph [0021] and at Figures 3 and 4, for example.

Dependent claims inherit all of the limitations of the respective parent claim.

In alleging anticipation, the Examiner comments that Chevassus teaches the means for actuating comprises a button (22) (col. 5, lines 18-31). Instant Office Action, page 2.

At column 5, lines 17-25, Applicant finds Chevassus to teach a two-state contactor 22 on the lower surface 12 of casing 10, where the assembly of contactor 22 on surface 12 is made such that the contactor automatically changes state when the casing 10 is placed on the plane support 14.

Here, Applicant finds Chevassus to teach an actuator 22 that serves the purpose of automatically causing a change of state in response to the casing 10 being placed on a support surface 14, which is substantially different from the claimed invention where a change of state occurs under the direct manual control of a user's hand, and does not occur automatically when the claimed device is placed on a table.

In comparing Chevassus with the claimed invention, Applicant finds Chevassus to be directed to an actuator 22 that changes state upon interaction with a table (surface 12) and to be completely absent any consideration of the actuator 22 being configured to change state on demand from the direct interaction of a user's hand.

As such, Applicant submits that Chevassus does not disclose all of the claimed elements arranged as claimed in the amended claims, and absent anticipatory disclosure in Chevassus of each and every element of the claimed invention arranged as in the claim, Chevassus cannot be anticipatory.

In view of the amendment and foregoing remarks, Applicant submits that Chevassus does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully

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submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chevassus in view of Reid et al. (U.S. Patent No. 6,853,365, hereinafter Reid).

Claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chevassus in view of Zagnoev (U.S. Publication No. 2003/0090394, hereinafter Zagnoev).

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevassus in view of Bonanni et al. (U.S. Patent No. 6,400,157, hereinafter Bonanni).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Claims 3-5 and 7-12 are claims dependent upon Claim 1.

Claims 14-15 are claims dependent upon Claim 13.

Dependent claims inherit all of the limitations of the respective parent claim.

In view of Reid, Zagnoev and Bonanni not being applied for purposes relating to the means for actuating, Applicant submits that the secondary references fail to cure the deficiencies of Chevassus as set forth above, and therefore cannot be properly used to establish a prima facie case of obviousness.

In addition to the foregoing, Applicant finds no motivation or teaching in any of the References to modify a primary Reference in view of its respective secondary Reference to arrive at the claimed arrangement of elements without disturbing the

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intended purpose of the art being modified (automatic mode switching upon contact with a support surface).

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention (manual manipulation to switch mode settings), fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

Regarding new Claim 16

Applicant has added new Claim 16 to capture previously disclosed but unclaimed subject matter. No new matter has been added as antecedent support can be found in the application as originally filed, such as in Claim 1, for example. In view of the comments set forth above regarding the allowability of Claim 1, Applicant submits that Claim 16 is allowable, and respectfully requests notice thereof.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

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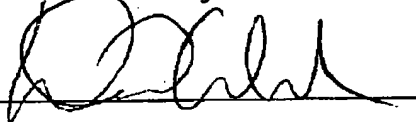
The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 50-2513.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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